

**REMARKS**

After entry of this amendment, claims 1-33 will be pending. Applicant respectfully requests reconsideration of all remaining claims in view of the remarks set forth below.

**Allowable Subject Matter**

Applicant kindly thanks the Examiner for the allowability of Claim 24. Applicant has accordingly amended Claim 24 to be in independent format to include the limitations of Claim 1.

**Rejection of claims 1, 6, 11 and 12 under 35 U.S.C. §102(b)**

The Examiner rejected claims 1, 6, 11 and 12 under 35 U.S.C. §102(b) as anticipated by Goldberg et al. (U.S. Patent 5,804,263). The Examiner states, citing to the portions of the reference at Col. 5, lines 7-10, that Goldberg uses a gamma beam radiation polymerization surface modification to produce a grafted polymeric surface. The Examiner states that the grafted polymeric surface of Goldberg anticipates the presently claimed invention.

To anticipate a claim, each and every claimed element must be found in the cited reference. MPEP § 2131.<sup>1</sup> Reviewing Goldberg, it is clear that this reference fails to disclose each and every element of the rejected claims. Instead, Goldberg could only arguably disclose grafting material on a polymer substrate, and nothing more. It cannot and does not teach a modular grafted polymeric surface adapted to support a species for a reaction. See language of Claim 1. This is especially true in light of the motivation behind Goldberg, which is to provide a surface that *does not* adhere to biomaterial. (See column 1, lines 15-40 of Goldberg). In fact, Goldberg never even discusses using its disclosed technology as a support for an active species in a chemical reaction.

Alternatively, independent Claim 1, as amended, recites an activated *modular* grafted polymeric surface *adapted to support an active species for a reaction*. [emphasis added]. This language imparts structural features that the surface is one which supports an active species in a reaction. *See In re Venezia*, 530 F.2d 956, 189 U.S.P.Q. (BNA) 149 (C.C.P.A. 1976) ('adapted to be fitted' over insulating jacket imparts structural limitation to sleeve

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*Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053

rather than merely directing activities to take place in future.). Such claim language "are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their 'broadest reasonable interpretation.'" *In re Marosi*, 710 F.2d 799, 802, 218 USPQ 289, 292 (Fed. Cir. 1983); *See also* MPEP 2111.01.

Accordingly, as disclosed on Page 5 of the present application, such active species may include, without limitation, scavengers, catalysts, or reagents for a chemical reaction. The dependent claims further define these features with more specificity. These active species are supported by the polymeric surface and assist the reaction process. Moreover, the polymeric surface is not just any surface, and is instead a modular surface. Such surfaces may include, without limitation, gears, beads, etc. These modular surfaces further lend themselves to assisting and contributing to reactions by positioning the active species at desired locations within the reaction environment or allowing ease of handling of the active agents.

Goldberg fails to disclose any device, especially a modular device, for supporting an active species. In fact, by virtue of Goldberg's teaching to not adhere to biomaterial (as discussed above), it actually teaches directly away from such a device. Therefore, not only does Goldberg fail to teach every claimed limitation, but it actually provides no suggestion or motivation to modify its teachings to the presently claimed invention. Accordingly, for the reasons set forth above, Applicant respectfully submits that Claim 1 and all claims depending therefrom are in a condition for allowance.

Rejection of claims 1, 6, 11-12, 18 and 25-29 under 35 U.S.C. §103(a)

Claims 1, 6, 11-12 and 18 are rejected under 35 USC § 103 as being obvious over McPherson et al. (U.S. Patent No. 6,013,855) in view of Goldberg et al. (U.S. Patent No. 5,804,263). Claims 1 and 25-29 are rejected under 35 USC § 103 as being obvious over McPherson et al. in view of Lukhtanov et al. (U.S. Patent No. 6,339,147).

At the outset, Applicant kindly submits that it is unclear whether McPherson is being submitted as an anticipating or obviousness type reference. This reference is only cited under the section of the Office Action entitled 35 USC § 103. However, the Examiner states that Goldberg anticipates the claimed invention. For clarification of the record and in accordance

with MPEP procedure, Applicant kindly requests the Examiner to state where in the reference each of the claimed limitations may be found and what claims are deemed anticipated. *In re Yates*, 663 F.2d 1054, 1057, 211 USPQ 1149, 1151 (CCPA 1981). See also *Ex parte Schricker*, 56 USPQ2d 1723, 1725 (BPAI) (unpublished) (The burden is on the Examiner to show where each of the claimed limitations are found in the prior art).

Nevertheless, to establish a *prima facie* case of obviousness, the applied reference must teach or suggest all the claimed limitations. MPEP §2143.<sup>2</sup> McPherson also fails to teach or suggest providing a modular support surface. In fact, McPherson fails to provide any description of any alleged support surface whatsoever. Goldberg and Lukhtanov fail to remedy this deficiency, as neither reference discloses a modular support surface. Accordingly, as the claimed limitations are not taught by the cited references, Applicant submits that Claims 1, 6, 11-12, 18, 25-29 are in a condition for allowance.

Moreover, assuming *arguendo* that the combined references did somehow teach the claimed limitations, Applicant submits that there is no suggestion or motivation to combine these references. Such suggestion or motivation is required to support a rejection under § 103. MPEP 2143. In fact, as discussed above, Goldberg teaches a device that resists combining with any biomaterial. Such device, for obvious reasons, would not work as a support for a material in a reaction. Simply, if the substrate resists supporting biomaterial or any other active species, there is no suggestion or motivation to combine it with a reference such as McPherson to form a substrate for supporting an active species for a reaction. Accordingly, for the reasons set forth above, Applicant submits that Claims 1, 6, 11-12, 18, 25-29 are in a condition for allowance.

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<sup>2</sup> *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

**CONCLUSION**

For at least these reasons, this application is now in condition for allowance. It is believed that any additional fees due with respect to this paper have already been identified in any transmittal accompanying this paper.

However, if any additional fees are required in connection with the filing of this paper that are not identified in any accompanying transmittal, permission is given to charge account number 18-0013 in the name of Rader, Fishman and Grauer PLLC.

If the Examiner has any questions or comments, she is kindly urged to call the undersigned to facilitate prosecution.

Respectfully submitted,

Date: June 24, 2003

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